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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,275	07/03/2001	Ihor W. Tamawskyj	D/A1017	9968
7590 10/22/2003				
Patent Documentation Center Xerox Corporation Xerox Square 20th Floor 100 Clinton Ave. S. Rochester, NY 14644			EXAMINER WOODWARD, ANA LUCRECIA	
			ART UNIT 1711	PAPER NUMBER

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 7/29/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-22 is/are pending in the application.
- Of the above claim(s) 12, 15, 16, 19, 20 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-11, 13, 14, 17, 18, 21, 22 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, with polyamide in mixture of methanol and 1-propanol, dihydroxy tetraphenyl biphenylene diamine in ethyl acetate and carbon black as the preferred species in Paper filed July 29, 2003 is acknowledged. The traversal is on the ground(s) that all claims can be examined together without undue burden, as can the various species encompassed by the instant claims. This is not found persuasive because contrary to applicants' contention, examination of all claims and the various species encompassed by the instant claims would require a serious burden due to the plurality of different classifications encompassed by the plurality of claimed embodiments because the search fields are not co-extensive.

Furthermore, applicants have not submitted evidence or identified such evidence now of record showing the species to be obvious variants or clearly admitted on the record that this is the case.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 12, 15, 16, 19 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper filed July 29, 2003.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 1-10, 13, 14, 17, 18, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the materials set forth at claim 11, does not reasonably provide enablement for the indefinite and generic terminology “charge transporting molecule”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

5. Claims 1-11, 13, 14, 17, 18, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 21, the metes and bounds of the generic term “polymer” are indeterminate in scope. As presently recited, such reads on the charge-transporting molecule of component b).

In claims 1, 21 and 22, “charge transporting molecule” and “charge transport solution” are indefinite as to scope and meaning.

In claim 6, “general” is indefinite.

In claim 6, there is no express antecedent basis for “said polyamide”.

In claim 6, the depicted formula is devoid of end groups and, as such, it is not definitive of a polymer.

In claim 17, it is unclear how the addition of the conductive filler and solvent in c) further limits the addition of the same materials in d) per the base claim. Are the components the same or different?

Allowable Subject Matter

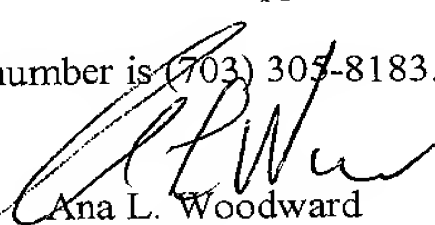
6. No anticipatory art has been found relative to applicants' ultimate species process embodiment comprising mixing an alcohol solution of polyamide, an acetate solution of dihydroxy tetraphenylbiphenylene diamine and a solvent solution of carbon black. Accordingly, claims directed to said particular embodiment would be allowable.
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (703) 308-2401. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8183.


Ana L. Woodward
Examiner
Art Unit 1711

AW